

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 14 and 41, claims 11, 12, 15 to 20, 28, 31 to 33, 39, 40, 42, and 43 are presently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the present application is in condition for immediate allowance, and reconsideration is respectfully requested.

II. Drawings

As an initial matter, it is noted that the Office Action Summary states that the drawings are objected to. However, no stated grounds of objection are present in the “Detailed Action.” Clarification is respectfully requested.

III. Rejection of Claims 39 to 43 Under 35 U.S.C. § 112, First Paragraph

Regarding the rejection of claims 39 to 43 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement, the Examiner’s attention is respectfully directed to, e.g., page 6, lines 15 to 16 of the Specification, which states that “[a] surgical instrument . . . may be inserted into the tubular member 1 and may be advanced distally therethrough.” The Specification further states that such a surgical instrument is described in numerous patent applications and patents, which are incorporated by reference and therefore are “as much a part of the [present] application as filed as if the text was repeated in the [present] application, and should be treated as part of the text of the [present] application as filed,” M.P.E.P. § 2163.07(b). Among surgical instruments described in the documents incorporate by reference are surgical stapler apparatuses. Accordingly, claims 39, 40, 42, and 43 are sufficiently enabled. Claim 41 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 41.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 39 to 43 Under 35 U.S.C. § 112, Second Paragraph

Regarding the rejection of claims 39 to 43 under 35 U.S.C. § 112, second paragraph as allegedly indefinite, while this rejection cannot be understood and while this rejection is not necessarily agreed with, to facilitate matters, claims 39, 40, 42, and 43 have been amended herein without prejudice to change “orifice introducer device” to --device--, and claim 41 has been canceled herein without prejudice. As such, it is respectfully submitted that the present rejection is moot, and withdrawal of the present rejection is respectfully requested.

V. Rejection of Claims 11, 12, 14 to 17, 20, 28, 31 to 33, and 39 to 43 Under 35 U.S.C. § 102(b)

Claims 11, 12, 14 to 17, 20, 28, 31 to 33, and 39 to 43 were rejected under 35 USC 102(b) as anticipated by U.S. Patent No. 5,176,127 (“Dormia”). It is respectfully submitted that Dormia does not anticipate the present claims for at least the following reasons.

As an initial matter, claims 14 and 41 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 14 and 41.

Dormia describes a mandrel (2) for an endoscope having a tubular jacket (1). The mandrel extends through the entire lumen of the jacket (1) and has a mandrel head (9) on the distal end that can be expanded radially to be flush with the distal end of the jacket (1), as shown in Fig. 6. The mandrel head however is not connected to the distal end of the jacket in any manner. Thus, the mandrel head is also not detachably connected to the distal end of the jacket. Rather, Dormia describes a coupling can be provided at the proximal end (actuation side) of the mandrel for connecting the mandrel to the jacket (col 3, lines 63 to 67). Furthermore, Dormia fails to disclose an annular groove provided in a proximal end of a distal portion that receives a distal end of a tubular member. Thus, Dormia does not disclose all the features of claims 11, 28, and 39.

With respect to claim 33, Dormia uses a slide (10) to expand the mandrel head (9) to the same diameter as the jacket (1), and when the slide is removed the head will return to its normal diameter. According to the present application, the distal head is kept in the expanded position by being connected to the tubular member at the annular groove, and the tubular insertion device is inserted into the lumen to detach the distal portion from the tubular member. Thus, Dormia fails to disclose the step of detaching by inserting a tubular insertion device through the tubular member for contacting an inner wall of the distal portion.

VI. Rejection of Claims 11, 12, 14, and 20 Under 35 U.S.C. § 102(b)

Claims 11, 12, 14 and 20 were rejected under 35 USC 102(b) as anticipated by U.S. Patent No. 5,931,776 (“Dotolo”). It is respectfully submitted that Dotolo does not anticipate the present claims for at least the following reasons.

As an initial matter, claim 14 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 14.

Dotolo discloses a speculum with a dissolvable tip. The tip (12) is not detachably connected to the tubular member (10), since the entire tip is not removed, but rather the tip gradually dissolves. The Office Action improperly considers dissolvable as being detachably connected. Although the tip may have a decreased diameter as it dissolves, this cannot be considered to contract. Additionally, Dotolo fails to show an annular groove in the tip that receives the distal end of the tubular member. The Office Action refers to annular shoulder 16 as an annular groove, however the shoulder merely rests against the end of the speculum and does not receive the speculum in a groove (col 2, lines 15 to 26). Thus, a shoulder cannot be considered to be a groove. Therefore, Dotolo fails to disclose all the features of claim 11, as well claims 12 and 20, which depend from claim 11.

VII. Rejection of Claims 39 to 43 Under 35 U.S.C. § 103(a)

Claims 39 to 43 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Dormia and U.S. Patent No. 6,042,538 (“Puskas”). It is respectfully submitted that the combination of Dormia and Puskas does not render unpatentable the present claims for at least the following reasons.

As an initial matter, claim 41 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 41. As a further initial matter, Applicants do not agree with the contentions set forth in paragraph 15 of the Office Action and respectfully traverse those contentions.

As more fully set forth above, Dormia does not disclose all of the features included in claim 39. Puskas is not relied upon for disclosing the features not disclosed by Dormia. As such, it is respectfully submitted that the combination of Dormia and Puskas does not render unpatentable claim 39, or any of claims 40, 42, and 43, which depend from claim 39.

VIII. Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)

Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dormia. It is respectfully submitted that Dormia does not render unpatentable the present claims for at least the following reasons.

Claims 18 and 19 ultimately depend from claim 11 and therefore include all of the features included in claim 11. As more fully set forth above, Dormia does not disclose all of the features included in claim 11. Accordingly, it is respectfully submitted that Dormia does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IX. Conclusion

In view of the above amendments and remarks, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested

Respectfully submitted,

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